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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,291	09/19/2003	D. Clayton Evans	PU2177	2290
23454	7590	03/23/2004		
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			EXAMINER PASSANITI, SEBASTIANO	
			ART UNIT 3711	PAPER NUMBER
DATE MAILED: 03/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/605,291

**Applicant(s)**

EVANS ET AL.

**Examiner**

Sebastiano Passaniti

**Art Unit**

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 09/19/2003 – application papers filed.

This application is a CON of 10/063,927, filed 05/24/2002, now US Pat. No. 6,623,377, which is a CON of 09/606,809, filed 06/28/2000, now US Pat. No. 6,398,666, which is a CIP of 09/841,167, filed 01/12/2000, now US Pat. No. 6,368,234, which is a CIP of 09/431,982, filed 11/01/1999, now US Pat. No. 6,354,962.

Claims 1-7 are pending.

Following is an action on the MERITS:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,623,377.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '377 patent, when specifically compared to instant claim 1, differs only in the recitation of the thickness of the central region. One of

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ordinary skill in the art would have found it obvious to modify the thickness of the central region of the '377 device given that a change in the thickness of the striking face will naturally affect not only the flex of the striking plate, but also the weight of the head. As to instant claim 2, note that claim 2 of the '377 patent differs only in the order in which the claimed range is presented. As to instant claim 3, the claimed thickness is merely deemed to be an obvious variation over that which is claimed in the '377 patent, as again, the skilled artisan would have had enough common knowledge to understand the effect on club head weight and ball striking performance with changing thickness values. As to instant claim 4, note claim 4 of the '377 patent, where again the only difference between the two claimed inventions is the order in which the range of thicknesses is recited. As to instant claims 5-7, the claims of the '377 patent are more specific and therefor encompass all of the limitations of the instant claimed invention. The lack of instant claims 5-7 to require a specific volume range, as is required by the '377 patent, is not deemed to patentably distinguish over the '377 patent, as the values set forth in the '377 patent are well-known examples for the interior volume of a club head. The skilled artisan would have found it obvious to vary the club head volume based upon specific weight requirements.

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,398,666. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '666 patent merely differ in the thickness requirements for the thickness of the diverse regions and require the added requirement

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that the striking plate have a core face area. These differences may be explained in much the same manner as the differences between the instant claimed invention and the '377 patent, as set forth above. Thus, a detailed explanation is not deemed necessary, here. Clearly, the skilled artisan would have found it obvious to modify the claimed invention of the '666 patent to include diverse thickness ranges based upon the club maker's desire to suitably distribute the weight of the head and obtain a specific ball-striking response, i.e., more or less flexure upon ball impact.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel\_\_\_\_, Frame\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:\_\_\_\_\_ To:\_\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an


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application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
March 19, 2004

PTO/SB/26 (10-00)

Approved for use 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TERMINAL DISCLAIMER TO OBIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT</b>	Docket Number (Optional)
<p>In re Application of:</p> <p>Application No.:</p> <p>Filed:</p> <p>For:</p> <p>The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. _____. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right; margin-top: 20px;"> <div style="display: inline-block; width: 45%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: inline-block; width: 45%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: flex; justify-content: space-around; width: 100%;"> <span>Signature</span> <span>Date</span> </div> <div style="border-bottom: 1px solid black; margin-top: 10px; width: 100%;"></div> <div style="text-align: center;">Typed or printed name</div> </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p style="text-align: center;"><b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b></p> <p style="text-align: center;">*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</p>	

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: \_\_\_\_\_

Application No.: \_\_\_\_\_ Filed: \_\_\_\_\_

For: \_\_\_\_\_

\_\_\_\_\_, a \_\_\_\_\_,  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : \_\_\_\_\_

Name : \_\_\_\_\_

Title : \_\_\_\_\_

Signature: \_\_\_\_\_